

REMARKS

The Final Official Action mailed October 18, 2004 and Advisory Action mailed February 17, 2005, has been received and its contents carefully noted. Filed concurrently herewith is a *Request for Two Month Extension of Time*, which extends the shortened statutory period for response to March 18, 2005. Also, filed concurrently herewith is a *Request for Continued Examination*. Accordingly, the Applicants respectfully submit that this response is being timely filed.

Claims 1-9, 16 and 18-32 are pending in the present application. Independent claims 1, 16, 18 and 30 have been amended to better recite the features of the present invention. Claims 24-26 have been withdrawn from consideration. The Applicants note with appreciation the allowance of claim 6 (page 10, Paper No. 19). Accordingly, claims 1-9, 16, 18-23 and 27-32 are currently elected, of which claims 1, 16, 18 and 30 are independent and claim 18 is generic. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 4 of the Official Action urges cancellation of non-elected claims 24-26. However, as noted by the Examiner, it was agreed that claim 18 is generic (page 2, Paper No. 13). Since claim 18 is generic, claims 24-26 will be in condition for allowance upon allowance of claim 18. Therefore, the Applicants respectfully submit that cancellation of claims 24-26 is not necessary at this time.

Paragraph 6 of the Official Action rejects claims 1-5, 7-9, 16, 18-23 and 27-32 as obvious based on the combination of U.S. Patent No. 5,497,366 to Fujisawa and EP 0316959 to Noda et al. The Applicants respectfully submit that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present invention, as amended.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available

to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Please incorporate the arguments presented at pages 10-14 of the *After Final Amendment* filed January 18, 2005.

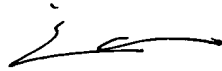
Further to the *After Final Amendment* filed January 18, 2005, the Applicants have further amended independent claims 1, 16, 18 and 30 to recite an optical pickup apparatus which serves to focus the spots (M, E, F, G, H, I and J) lining up in a single file of a plurality N of light beams onto a plurality N of adjacent tracks of a recording medium and detect a plurality N of reflected lights from said tracks, whereby simultaneously reading out a plurality N of pieces of data recorded on said tracks, where N is an integer more than two. Also, independent claims 1 and 16 have been amended to recite a plurality N of adjacent photodetectors (52M, 52E, 52F, 52G, 52H, 52I, and 52J) lining up in a single file. The Applicants respectfully submit that Fujisawa and Noda, either alone or in combination, do not teach or suggest at least the above-referenced features of the present invention.

Since Fujisawa and Noda do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration

and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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